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REMARKS

The Office Action notes that claims 1-24 are pending in the referenced application, that claims 1-4, 6-12, 14-20, and 22-24 are rejected, and claims 5, 13, and 21 are objected to. In view of the following discussion, the Applicants submit that none of the claims now pending in the application is obvious under the provisions of 35 U.S.C. § 103. Thus, the Applicants believe that all of these claims are now in allowable form.

I. CLAIMS 5, 13 AND 21 HAVING ALLOWABLE SUBJECT MATTER

Applicants acknowledge and express their appreciation for the indication in Paragraph 4 of the Office Action that claims 5, 13, and 21 contain allowable subject matter, "if rewritten in independent form including all of the limitations of the base claim and any intervening claims".

Responsive to the Examiner's objections to claims 5, 13, and 21, Applicants respectfully request reconsideration of the Examiner's determination that these dependent claims depend upon a rejected base claim for the reasons set forth below.

It is respectfully submitted that Applicants' explanation below, place claims 5, 13, and 21 in condition for allowance. Thus, the Applicants believe that all of these claims are now in allowable form.

II. REJECTION OF CLAIMS 1-4, 6-12, 14-20, and 22-24 UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-4, 6-12, 14-20, and 22-24 in the Office Action as being obvious over Hurst, Jr. (US patent 6,038,000, issued on March 14, 2000) in view of Wee et al (US patent 6,104,441, issued on August 15, 2000). The Applicants respectfully disagree.

Hurst, Jr. teaches a method and apparatus for splicing a first compressed digital information stream into a second compressed digital information stream. The first information stream includes at least one entrance indicium identifying an appropriate stream entrance point. The second information stream includes at least one exit

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indicium identifying an appropriate stream exit point. A controller monitors the two streams until the appropriate points are found and, in response to a control signal, splices the first stream into the second stream. (See Hurst, Jr., Abstract) The splicer includes a pre-splice buffer receiving a first information stream and producing a buffered information stream; a bitstream examiner receiving the first information stream and responsively causing the pre-splice buffer to position an entrance point of the buffered information stream at an output of the buffer; a switch for coupling either the buffered information stream or a second information stream to an output; and a switch controller for monitoring the second information stream, and in response to a control signal and the detection of an exit point in the second information stream, causing the switch to couple the buffered information stream to an output. (See Hurst, col. 2, lines 4-15)

Wee discloses an image editing system that permits manipulation of compressed elementary stream images without full decompression into the image domain. In particular, Wee teaches a method of using discrete cosine transform coefficients of dependent frames within a compressed elementary stream image sequence to incorporate DCT representations of anchor frames. This allows re-ordering of the frames in the compressed elementary stream domain without violating temporal dependencies. Frames can be cut and then re-ordered to overcome temporal dependencies on the eliminated frames. (See Wee, Abstract)

The Examiner states that Hurst, Jr. fails to disclose a decoder for decoding each identified (out/in)-frame within a transport stream, a respective portion of the transport stream including the (out/in)-frame, and an encoder for re-encoding each decoded portion of the transport stream to produce a (out/in)-point adapter. The Examiner then states that Wee et al teaches decoding an identified out-frame, a portion of the video stream including the out-frame, and re-encoding each decoded portion of the stream for splicing purpose. Lastly, the Examiner states that it would have been considered quite obvious to a person of ordinary skill in the relevant art employing Hurst, Jr's reference to incorporate the concept as taught by the Wee et al so that the decoder decodes each identified (out/in)-frame, a respective portion of the transport stream including the

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(out/in)-frame, and the encoder re-encodes each decoded portion of the transport stream to produce a (out/in)-point adapter for a frame accurate splicing operation.

Applicants respectfully disagree. Applicants respectfully request the Examiner to provide support in the cited references that shows the motivation to combine the cited references against Applicants' invention. Failing to cite this motivation, the Examiner is simply using impermissible hindsight.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. See also Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

Applicants submit that the Examiner has failed to establish a prima facie case of obviousness against Applicants' claims. Thus, Applicants submit that claims 1-4, 6-12, 14-20, and 22-24 are not made obvious by the teaching of Hurst, Jr. in view of Wee et al.

Conclusion

Thus, the Applicants submit that all of these claims now fully satisfy the requirements of 35 U.S.C. §103. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so

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that appropriate arrangements can be made for resolving such issues as expeditiously as possible. ·

Respectfully submitted,

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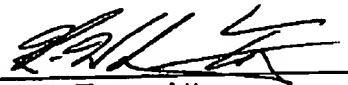
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